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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,372	06/08/2001	Konrad Scholz	H 4858	2436

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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,372

Applicant(s)

SCHOLZ, KONRAD

Examiner

Jessica L. Rossi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/1/04, RCE.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 9, 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8, 10-12, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A (appears to be claims 5-9, 10-12, 14-15), drawn to a bandlike covering.

Species B (appears to be claims 5-9, 13), drawn to a film.

*upon election of **Species A**, applicant must make a further species election:

Species Ai (appears to be claims 5-9, 10-12, 14-15), drawn to a board element.

Species Aii (appears to be claims 5-9, 14-15) drawn to a profile bar.

*upon election of Species Ai, applicant must make a further species election:

Species Aix (appears to be claims 5-9, 10-12, 14-15), drawn to the narrow face having a straight cross section as shown in Figure 1 (note length of pressure element less than that of narrow face when straight cross section).

Species Aiy (appears to be claims 5-9, 14), drawn to the narrow face having a profiled cross section as shown in Figure 2.

*upon election of Species Aix, applicant must make a further species election:

Species Aixa (appears to be claims 5-8, 10-12, 14-15), drawn to the deformable face being an elastic band.

Species Aixb (appears to be claims 5-7, 9-12, 14-15), drawn to the deformable face being a spring-steel band.

*upon election of Species Aiy, applicant must make a further species election:

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Species Aiya (appears to be claims 5-8, 10-12, 14-15), drawn to the deformable face being an elastic band.

Species Aiyb (appears to be claims 5-7, 9-12, 14-15), drawn to the deformable face being a spring-steel band.

*upon election of Species Aii, applicant must make a further species election:

Species Aiix (appears to be claims 5-9, 14-15), drawn to the narrow face having a straight cross section as shown in Figure 1 (note length of pressure element less than that of narrow face when straight cross section).

Species Aiiy (appears to be claims 5-9, 14), drawn to the narrow face having a profiled cross section as shown in Figure 2.

*upon election of Species Aiix, applicant must make a further species election:

Species Aiixa (appears to be claims 5-8, 14-15), drawn to the deformable face being an elastic band.

Species Aiixb (appears to be claims 5-7, 9, 14-15), drawn to the deformable face being a spring-steel band.

*upon election of Species Aiiy, applicant must make a further species election:

Species Aiiya (appears to be claims 5-8, 14), drawn to the deformable face being an elastic band.

Species Aiiyb (appears to be claims 5-7, 9, 14), drawn to the deformable face being a spring-steel band.

*upon election of **Species B**, applicant must make a further species election:

Species Bi (appears to be claims 5-9, 13), drawn to a board element.

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Species Bii (appears to be claims 5-9, 13) drawn to a profile bar.

*upon election of Species Bi, applicant must make a further species election:

Species Bix (appears to be claims 5-9), drawn to the narrow face having a straight cross section as shown in Figure 1.

Species Biy (appears to be claims 5-9, 13), drawn to the narrow face having a profiled cross section as shown in Figure 2 (note narrow face contacts an entry zone when profiled cross section).

*upon election of Species Bix, applicant must make a further species election:

Species Bixa (appears to be claims 5-8, 13), drawn to the deformable face being an elastic band.

Species Bixb (appears to be claims 5-7, 9, 13), drawn to the deformable face being a spring-steel band.

*upon election of Species Biy, applicant must make a further species election:

Species Biya (appears to be claims 5-8, 13), drawn to the deformable face being an elastic band.

Species Biyb (appears to be claims 5-7, 9, 13), drawn to the deformable face being a spring-steel band.

*upon election of Species Bii, applicant must make a further species election:

Species Biix (appears to be claims 5-9), drawn to the narrow face having a straight cross section as shown in Figure 1.

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Species Biiy (appears to be claims 5-9, 13), drawn to the narrow face having a profiled cross section as shown in Figure 2 (note narrow face contacts an entry zone when profiled cross section).

*upon election of Species Biix, applicant must make a further species election:

Species Biixa (appears to be claims 5-8), drawn to the deformable face being an elastic band.

Species Biixb (appears to be claims 5-7, 9), drawn to the deformable face being a spring-steel band.

*upon election of Species Biiy, applicant must make a further species election:

Species Biiya (appears to be claims 5-8, 13), drawn to the deformable face being an elastic band.

Species Biiyb (appears to be claims 5-7, 9, 13), drawn to the deformable face being a spring-steel band.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 5 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the

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limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Mr. Scioli on 7/2/04 a provisional election was made without traverse to prosecute **Species Aixa, claims 5-8, 10-12, and 14-15**. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-4, 9, and 13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Note rejoinder to Species will be considered upon the discovery of allowable subject matter, depending on the basis thereof.

Response to Amendment

4. The request filed on 4/1/04 for a RCE under 37 CFR 1.114 based on parent Application No. 09/877,372 is acceptable and a RCE has been established. An action on the RCE follows.

5. The rejection of claim 5 under 35 USC 102(b) as being anticipated by Finke ('783; of record), as set forth in paragraph 4 of the previous office action, has been withdrawn in light of the present amendment to the claim.

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6. The rejection of claims 5 and 8 under 35 USC 102(b) as being anticipated by La Mers ('050; of record), as set forth in paragraph 5 of the previous office action, has been withdrawn in light of the present amendment to the claim.

7. The rejection of claims 5 and 8-9 under 35 USC 102(e) as being anticipated by Wu et al. ('335; of record), as set forth in paragraph 6 of the previous office action, has been withdrawn in light of the present amendment to the claim.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5-8, 10-12, and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 5, it is unclear if the "narrow face" belongs to just the board element or both the board element and profile bar have a narrow face. Based on the claim language set forth in lines 3-4 and 6-7 ("film being pressed onto the narrow face or profile bar" in lines 3-4 and "the shape of the narrow face or of the profile bar" in lines 6-7) it appears Applicant intends the former. However, based on the present specification and subsequent claims, it appears that both the board and bar have a narrow face. Applicant is asked to clarify. It is suggested to amend the claim to state "film being pressed onto the narrow face of the board element or of the profile bar" in lines 3-4 and "the narrow face of the board element or of the profile bar" in lines 6-7.

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With respect to claim 5, it is unclear if the “the surface of straight or profiled cross section” in lines 2-3 refers to the cross section of a surface of the narrow face or the cross section of a surface of the board element/profile bar. Applicant is asked to clarify. It appears that Applicant is attempting to describe the cross section of the narrow face and therefore should amend the claim to make this very clear.

With respect to claim 5, it recites the limitation "the pressure head" in line 8. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change “head” to --element--.

With respect to claim 10, it recites the limitation "adhesive" in line 7. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change “adhering the covering and adhesive” in line 7 to --adhering the covering and an adhesive--.

With respect to claim 14, it recites the limitation "the pressure head" in line 6. There is insufficient antecedent basis for this limitation in the claim. It is suggested to change “head” to --element--.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 5-6, 8, 10-12, and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Duewel (US 4222812).

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With respect to claim 5, Duewel is directed to a method for gluing a bandlike covering 14 onto the edge (= narrow face) of a board element 20 having a surface of straight cross section with an adhesive (Figure 1; column 1, lines 6-15; column 3, lines 35-40). The reference teaches a spindle 18 which has an outer sleeve 86 of **resilient** material that comes into contact with the covering and serves as a pressure member for urging the covering against the edge of the board element (**column 6, lines 23-27**). The skilled artisan would have readily appreciated that the resilient material of the sleeve would inherently be elastically deformable and therefore exert uniform pressure on the shape of the edge (narrow face). The reference also teaches moving the board element along its length in relation to the pressure element while the covering is pressed onto the edge (column 6, lines 29-31 and 23-26).

Regarding claim 6, the reference teaches the adhesive being a hot melt (column 3, lines 36-37; column 4, lines 30-32).

Regarding claim 8, the skilled artisan would have appreciated that the resilient/elastic sleeve is an elastic band.

With respect to claim 10, all the limitations were addressed above with respect to claim 5, except the spindle 18 having a length which is less than that of the edge (narrow face). The reference teaches such as clearly shown in Figure 1.

Regarding claim 11, this limitation was addressed above with respect to claim 5.

Regarding claim 12, the reference teaches the spindle 18 having a length that is substantially shorter than that of the edge (narrow face) as shown in Figure 1.

With respect to claim 14, all the limitations were addressed above with respect to claim 5.

Regarding claim 15, this limitation was addressed above with respect to claim 12.

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Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duewel as applied to claim 5 above and further in view of PCT WO 99/58307 (provided in IDS).

Regarding claim 7, applicant is directed to paragraph 11 above for a complete discussion of Duewel. Duewel is silent as to a particular type of board. Selection of a particular type of board would have been within purview of the skilled artisan at the time the invention was made depending on the intended use of the finished article and the desired properties thereof. However, it would have been obvious to use boards such as chipboard, fiber board, or solid wood board because it is known in the art to apply bandlike coverings to the narrow faces thereof, as taught by PCT '307 (p. 1, lines 6-10).

Response to Arguments

14. Applicant's arguments with respect to claims 5-9 have been considered but are moot in view of the new ground(s) of rejection. Note the newly applied reference to Duewel does teach movement of the board element along its length, in relation to the pressure element, while the covering is uniformly pressed onto the narrow face.

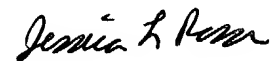
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine R. Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jessica L. Rossi
Patent Examiner
Art Unit 1733